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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,409	03/01/2004	Daniel Perlman	PRLMN-002XX	1457
207	7590	07/27/2005	EXAMINER	
WEINGARTEN, SCHURGIN, GAGNEBIN & LEOVICI LLP			MANAHAN, TODD E	
TEN POST OFFICE SQUARE			ART UNIT	
BOSTON, MA 02109			PAPER NUMBER	

3732

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/790,409

Applicant(s)

PERLMAN, DANIEL

Examiner

Todd E. Manahan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>7/19/04</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Objections

Claim 10 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 10 is merely rewording of lines 12-14 of base claim 1 and as such does not further claim 1.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 9, the functional recitation that "said applicator element is compliant to the nail surface" is indefinite because it is not supported by recitation in the claim of sufficient structure to accomplish the function.

In claim 11, the functional recitation that "said applicator element and said flow valve obviate the need for a nib" is indefinite because it is not supported by recitation in the claim of sufficient structure to accomplish the function.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 6, and 9-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Geremia-Nargi (United States Patent No. 6,244,773).

Geremia-Nargi discloses a device comprising a vessel 14 containing a liquid solvent and having an opening; an applicator element 36 which is chemically resistant and permeable to the solvent secured over the opening; and a valve assembly arranged beneath the applicator element comprising a liquid flow valve that can be opened and closed by increasing or decreasing manual pressure on the applicator element (see figure 3). The vessel has a generally elongated shape with a polygon cross-section. The applicator element is convex outward.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-5, 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Geremia-Nargi.

Geremia-Nargi discloses the claimed invention except for the vessel sized to hold 10-100 ml (claim 3) or the applicator element having an area of 0.5-2.0 cm² (claims 4-5). It would have been obvious to one having ordinary skill in the art at the time the invention was made to size the vessel to hold 10-100 ml and/or make the applicator element with an area of 0.5-2.0 cm² since it has been held that where the general conditions of a claim are disclosed in the prior art,

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discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233. Regarding claims 7 and 8, Geremia-Nargi discloses the claimed invention except for the applicator element being open cell foam, fabric, non-woven fiber, aligned fiber, or porous plastic (claim 7) and made of polyolefins, polyesters, polyurethanes, polycarbonates, or nylons (claim 8). It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the applicator of open cell foam, fabric, non-woven fiber, aligned fiber, or porous plastic and made of polyolefins, polyesters, polyurethanes, polycarbonates, or nylons, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones (United States Patent No. 3,592,202) in view of Buschemeyer (United States Patent No. 4,772,148).

Jones discloses the invention essentially as claimed except for the applicator being a porous material and the valve assembly. Buschemeyer discloses that it is known in the art to provide a liquid applicator with a porous membrane applicator element and a valve assembly in order to make the device spill proof (see col. 1, lines 20-21). It would have been obvious to one skilled in the art to replace the applicator element of the device of Jones with a porous membrane and valve assembly in view of Buschemeyer in order to make the device spill proof. Regarding method claims 12-17, the method of using the device to remove nail polish would be inherent in the combination of Jones and Buschemeyer.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

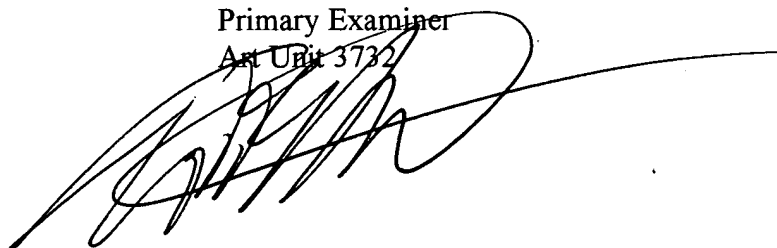
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Todd E. Manahan whose telephone number is 571 272- 4713. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on 571 273-4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Todd E. Manahan
Primary Examiner
Art Unit 3732

T.E. Manahan
20 July 2005

A large, stylized handwritten signature in black ink, likely belonging to Todd E. Manahan, is written over the printed name and title.